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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent application of
John I. Ykema

Serial No.: 09/213,099

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For: POWER NODE CONTROL CENTER

Group Art Unit: 2841

Examiner: T. Phan

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SUPPLEMENTAL RESPONSE TO THIRD RESTRICTION REQUIREMENT

Traverse, Request For Reconsideration And Provisional Election

This is submitted in further response to an office action having no paper designation number but dated 9 April 2003 wherein the examiner again required, for a third time, restriction of the subject matter disclosed in the above-referenced patent application.

Applicant filed a response paper in a timely fashion on 11 August 2003. In reviewing that paper, applicant has noted several typographical errors therein. At least one of those errors, appearing in line 3 on page 10, is important. That error misstated the examiner's evidentiary burden, saying "...it is the examiner's burden to show *lack of*

patentability...” when it should have said “...it is the examiner’s burden *to show patentability...*”. Applicant regrets the error and submits this Supplemental Response in part to correct the same.

Applicant, through his undersigned attorney, hereby traverses the third restriction requirement in all of its respects, requests reconsideration and withdrawal of the third requirement for restriction and again requests a prompt and thorough examination of all of the claims pending in the application, on their merits.

Without prejudice to the foregoing traverse and request for reconsideration and without prejudice to applicant's right to petition against the restriction requirement, in compliance with the requirement set forth in the official action applicant provisionally elects the claims of Group I, namely claims 1-24, 35, 52-74 and 80-93, which the examiner has characterized as being directed to electrical control module power nodes.

Legal, Practical and Equitable Considerations Mandate Examination of Applicant's Claims in a Single Action, As Was This Case With the First and Second Restriction Requirements

A repeated close examination of the legal, practical and equitable considerations surrounding the present case compels withdrawal of the examiner's restriction requirement and requires examination of all the claims presented in a single patent application.

In levying the restriction requirement, the examiner divided the claims pending in the application into four groups. The examiner again asserted, as in the second restriction requirement, that group I embraced claims 1-24, 35, 52-74 and 80-93, as being purportedly drawn to “an electric control module power nodes” (sic), which the examiner

asserted to be properly classified in class 361, this time in subclass 286, rather than in subclass 685 as had been the position in the second restriction requirement.

The examiner again asserted group 2 to embrace claims 25 and 75, as being purportedly drawn to a “power node control center”, which the examiner asserted to be properly classified in class 307, but this time in subclass 124, rather than in subclass 43 as had been the position in the second restriction requirement.

The examiner asserted group 3 to embrace claims 26-34, 36-45, 48-51 and 76-79 as being purportedly drawn to a “power bus backplane”, which the examiner asserted to be properly classified in class 361, but this time in subclass 788 rather than in subclass 752 as had been the position in the second restriction requirement.

The examiner further asserted that group 4 embraced claims 46 and 47 as being purportedly drawn to a “module”, which the examiner asserted to be properly classified in class 361, but this time in subclass 796 rather than in subclass 679 as had been the position in the second restriction requirement.

The independent claims the examiner asserted to be in group 1, namely claims 1, 52 and 80, broadly claim modular power control nodes having a backplane and functional modules connecting to the backplane. Claims 1 and 52 recite these features explicitly; claim 80 is directed to a power bus backplane and additionally recites a control module including programmable microprocessor means.

Claims 25 and 75, which the examiner asserted to be drawn to a power node control center of modular construction and hence to be in group 2, also recite a backplane and functional modules. Hence, claims 25 and 75 are broadly directed to the same subject matter as claims 1, 52 and 80.

Claims 26 and 76, which are the only independent claims in group 3, are directed to a power bus backplane and also include bus connectors with terminals for receiving modules such as are recited in independent claims 1, 52 and 80 of group 1 and in independent claim 46 of group 4.

Claim 46 is the independent claim in group 4 and recites a module for use with a backplane and having terminals to connect to the backplane.

The examiner asserts that the claims in these four groups define inventions which are purportedly "distinct". In support of this distinctness contention the examiner cites the provisions of MPEP 806.05(c) and states that inventions in a combination/subcombination relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability or (2) the subcombination has utility by itself or in other combinations.

The examiner has commingled the inventions purportedly defined by claim groups 1 through 3 in a manner which has thoroughly confused applicant. In paragraph 2 of the official action, the examiner asserts that the inventions of groups 1 through 3 are a combination. In paragraph 3 of the official action, the examiner asserts that the inventions of claim groups 1 and 2 are a combination. It is unclear to applicant as to which of the claim groups the examiner asserts is a combination and relates to claim group 4 in a combination/subcombination relationship. Clarification of the official action in this regard is respectfully solicited. Similarly, respecting paragraph 3 of the official action, it is unclear as to which of the claim groups the examiner asserts relates to claim group 3 as a combination/subcombination. Clarification again is respectfully solicited.

Without prejudice to the requests for clarification as set forth above and proceeding with applicant's best understanding of the official action, respecting the assertion raised by the examining attorney in paragraph 2 of the examiner's remarks to the effect that the inventions of groups 1 through 3 and groups 4 are related as combination/subcombination if it can be shown that the combination as claimed does not require the particulars of the subcombination as claimed for patentability or that the subcombination has utility by itself or other combinations, applicant traverses the same and requests reconsideration.

The subcombination addressed by the examiner in paragraph 2 is defined by claims 46 and 47 which are directed to a module. The examiner asserts that the subcombination has separate utility such as a "module" and the "module can be used in vary computer technology". Applicant respectfully submits it to be improper and illogical to assert that "a module has separate utility such as a module", which is what the examiner has effectively said. Note that if the examiner's definition for the "subcombination" is substituted into the last sentence of paragraph 2 of the official action, the examiner's position is that "the module has separate utility such as a module". This is illogical and nonsensical. Moreover, the examiner's assertion that "the module" can be used in other computer technology, for example in a computer system or a host system, is without basis. The examiner has provided no example whereby "the module", as described in detail in the specification and defined by the claims of group 4, is amenable to use in any other system other than the power node control system disclosed and claimed generally and broadly in the instant patent application.

Furthermore, the examiner asserts in paragraph 2 that “the combination” (and applicant reiterates that it is not clear as to whether “the combination” refers to the claims of group 1, the claims of group 2, the claims of group 3 or perhaps the claims of all three groups taken together) as claimed does not require the particulars of the subcombination, i.e. the module as claimed, because the combination allegedly “has separate utility such as the power distribution control system.” Applicant respectfully submits that the examiner has not made any showing of any way the inventions defined by the claims of group 1 and/or the claims of group 2 and/or the claims of group 3, could be used without the modules, which are an integral, key part of the power node control system disclosed in the instant application. Lacking such showing, applicant respectfully submits that the examiner has failed to sustain the examiner’s evidentiary burden and that the third restriction requirement should be reconsidered and withdrawn.

Similarly respecting paragraph 3 of the examiner’s remarks, the examiner has again cited MPEP 806.05(c) in asserting that distinctness is present as between the claims defining the combination and the claims defining the subcombination if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability or (2) that the subcombination has utility by itself or another combination. The examiner goes on to assert that the combination as claimed (and again applicant is unclear as to what the examiner is asserting to be “the combination as claimed”--whether this is the claims of group 1, the claims of group 2 or the claims of groups 1 and 2 taken together) has separate utility such as motor and vehicle technology. The examiner has taken this position without any evidentiary basis for support. Applicant respectfully submits that with the examiner failing to provide any evidentiary

basis for his speculation that the combination (whatever it may be--note applicant's position repeatedly stated above) "has separate utilities such as motor and vehicle technology", there is a requirement for supporting evidence. Lacking any support in the way of evidence, by way of example or otherwise, for the examiner's speculation that "the combination as separate utility such as motor or vehicle technology" the examiner has failed to sustain the examiner's evidentiary burden and, accordingly, the restriction requirement should be withdrawn.

Respecting the examiner's position set forth in paragraph 4 in which the examiner asserts that the inventions of groups 2 and 1 are related as subcombinations disclosed as being useable together in a single combination and that such subcombinations are distinct from each other if they are shown to be separately useable, the examiner asserts that the inventions defined by group 1 have separate utility such as "an electrical control module power nodes and not using the power node control center". In support of this the examiner cites MPEP 806.05(d).

Applicant respectfully submits that the examiner must do more than speculate as to the separate usability of the inventions defined by the claims of the respective groups. In that regard, applicant respectfully notes that independent claim 1, which is part of claim group 1, recites "an electrical module power node" and makes no mention of any "power control center" as inferentially suggested by the examiner in the examiner's remarks.

Regarding all of the examiner's postulated combination/subcombinations presented in support of the restriction requirement, applicant respectfully notes that the test for whether inventions are "distinct" is a multi-prong test: The term "distinct means

that two or more subjects as disclosed are related...but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER". MPEP 802.01. (emphasis in the original)

The examiner's assertions that the inventions of groups 1 through 3 and 4 are related as various combinations and subcombinations disclosed as being usable together, effectively concedes that the inventions of the four groups are "related."

Notably, the examiner made **no reference whatsoever** to the patentability prong of the distinctness test, namely whether the inventions defined by each one of the separate groups of claims are novel and unobviously patentable respecting the inventions defined by the other groups of claims.

Speculation as to the availability of subject matter which is an alternative to that defined one of the groups of claims and suitability of that alleged alternative subject matter for use with another group of claims does not satisfy the distinctness test. In order to show that two or more groups of claims are distinct by being separately usable one from another, the examiner must cite concrete examples, including components, alternative structure and the like by which the group of claims at issue could be used with something other than one or the other groups of claims that is subject to the restriction requirement. The examiner has failed to do this.

In support of all of this, the examiner cited MPEP 806.05(d) which states that two or more claimed subcombinations which are disclosed as being usable together in a single combination "are usually distinct from each other"¹ if they can be shown to be separately usable. It should be specifically noted that MPEP 806.05(d), on which the examiner

¹ Note that the MPEP says "usually," not "always".

based his distinctness position, addresses only the "separately usable" prong of the multi-prong test for distinctness; MPEP 806.05(d) **is silent respecting the patentability prong of the distinctness test, namely whether the inventions defined by the claims at issue are patentable over each other.**

For purposes of restriction analysis only, applicant is not necessarily in agreement with the examiner that the inventions defined by the claims, as segregated into the four groups which the examiner has defined, represent groups of inventions which are usable in any meaningful way alone, without using any of the inventions defined by the claims of another one of the four groups. It is not at all apparent to applicant that the "electrical control module power nodes" (the examiner's characterization of the claims placed into group 1) have any utility whatsoever without a power bus backplane, which is the examiner's characterization of the claims placed into group 3. It further is not at all apparent to applicant that something other than "electrically control module power nodes" (the examiner's characterization of the claims placed into group 1) could be used to define a "power node control center of modular construction" which is the subject matter of claims 25 and 75 placed by the examiner into group 2.

Applicant again notes that claim 1 in its current form recites "an electrical modular power node" which is recited to include "a power bus backplane" and "a plurality of functional modules" having a "connector for connection to a bus bar" of the backplane. Claim 1 is silent respecting any other power connection means. Hence, for purposes of restriction analysis **(and for that purpose only)** it must be concluded that the invention defined by claim 1 would have utility only with a power bus backplane, which is the subject of the claims of group 3, since the node has to receive power in order to

function and power would be available only from the power bus backplane (no other power supply element or source is recited). Applicant notes that the examiner has not made any showing of any other power bus backplane with which the invention defined by claim 1 could be used and have the required utility. Lacking such a showing, applicant accordingly respectfully submits that the examiner has not made an adequate showing of the purported separate utility of the claims of group 1 and group 3.

Applicant further notes that claim 46, which is the independent claim in group 4, specifically recites "a module **for use in connection with** a power bus backplane node...". Hence, by its very language, the "module" defined by claim 46 must be used with or as a part of "a power bus backplane node". The examiner has correctly noted that the claims of group 3 are drawn to a power bus backplane. Applicant notes that the claims of group 4, on their face, specifically require that the modules defined by those claims be used with a power bus backplane. Hence, the inventions defined by the claims of group 4 are not usable by themselves but must be used with a power bus backplane as recited in the claims of group 3. The examiner has made no showing of any other power bus backplane with which the claims of group 4 might be used. Lacking such a showing by the examiner, applicant respectfully submits that the examiner erred in contending that there are separate uses for the claims of group 4 and group 3.

Applicant respectfully submits that, **for purposes of restriction analysis only and without prejudice to whatever position applicant may take on patentability in the course of prosecution of the claims on their merits**, the claims in the four groups into which they have been segregated by the examiner may not be patentable over one another. Without prejudice to that position, applicant respectfully notes that whether or

not the claims of the respective four groups are patentable over one another, it is the examiner's burden to show patentability of the groups of claims vis-à-vis one another in order to satisfy the patentability prong of the distinctness test. Applicant respectfully notes that the third restriction requirement is conspicuously silent respecting the patentability of any claim, in any one of the four groups of claims, vis-à-vis any claim in any of the other three groups. Applicant further respectfully notes that the fact that the claims have been arbitrarily categorized into separate classes and subclasses by the examiner in levying the restriction requirement does not address the issue of the patentability of the groups of claims vis-à-vis one another, in the context of the patentability prong of the distinctness test for purposes for restriction analysis.

Applicant notes that there are many common elements shared by the independent claims the examiner segregated into separate, purportedly "distinct", groups. For example, independent claim 1 recites both a backplane and functional modules and has been assigned by the examiner to group 1. Independent claim 75, which the examiner relegates to group 2, similarly recites a backplane and functional modules. With these two claims broadly reciting common subject matter, i.e. backplane and functional module elements, applicant respectfully submits it is probably unlikely, for purposes of restriction analysis only, that the two claims are patentably unobvious vis-à-vis one another. There has been no showing of the same by the examiner, which showing is a prerequisite for a holding of distinctness and hence maintenance of the restriction requirement as between the claims of group 1 and group 2.

Similar conclusions follow from analyzing elements of others of the independent claims, notably independent claim 76 (placed by the examiner into group 3) vis-à-vis

independent claim 75 (placed by the examiner into group 2). Both claims recite "backplanes" with "bus bars" or "bus connectors". This being the case, applicant respectfully submits. **without prejudice and for restriction purposes analysis only**, it is probably unlikely that claims 75 and 76 are unobviously patentable one over another.

For the foregoing reasons, applicant respectfully submits that the examiner's restriction requirement is erroneous, does not meet the controlling criteria for a finding of distinctness and should be withdrawn.

The examiner has further based the distinctness position on an assertion that the inventions defined by the four segregated groups of claims are distinct because they purportedly "have acquired a separate status in the art as shown by their different classification...".² Applicant respectfully submits that this conclusion does not support a finding of distinctness. Classification in the sense used by the examiner relates to where the patents, which might issue containing such claims, would be classified. Asserting that the issuing patents would be differently classified inferentially presumes that the claims of the prospective patents would be patentably distinct one from another. However, as demonstrated above, there has been no showing by the examiner of patentable unobviousness among the four groups of claims. Without a showing of patentable unobviousness among the four groups of claims, the assertion that the claims in the four groups, were they to issue in different patents, would be in four different classes is unsupported speculation.

The examiner has also asserted that the claims defining the four groups of the invention are distinct because they purportedly "have acquired a separate status in the art

² Applicant notes that the examiner has changed, from the second restriction requirement, the subclasses into which the four claim groups would purportedly fall.

because of their recognized divergent subject matter...". Applicant respectfully submits there has been no showing of any divergent subject matter. Indeed, a straight-forward reading of the claims reveals that there are many, many elements which are common to the claims of the four groups, as discussed generally above. There has not been a showing of the claims defining the inventions of the four groups having acquired any separate status in the art or having been recognized by anyone as presenting "divergent" subject matter. Indeed, all of the claims in all of the groups are broadly directed towards power distribution using a control center defining a power node and a power bus backplane providing power to and/or taking power from that node. Applicant respectfully submits that far from presenting "divergent" subject matter, the claims arguably could better be characterized as presenting "convergent" subject matter. All of the claims could certainly be considered to converge towards a power node control center connected to and including a power bus backplane.

The examiner has also asserted that the application "contains claims directed to the following patentably distinct species of the claimed invention", contending that species 1 is defined by figures 1 through 8 and species 2 is defined by figures 9 through 13. The examiner has further taken the position that applicant is required under 35 USC 121 to elect a single disclosed species for prosecution on the merits to which the claims should be restricted if no generic claim is finally held to be allowable. The examiner further asserts that currently there are no generic claims. Applicant traverses all of this and request reconsideration of the examiner's genus/species position.

The manual of patent examining procedure in Section 806.04(t) makes it crystal clear that "it is not possible to define a generic claim with that precision existing in the

case of a geometrical term. In general, a generic claim should include no material element additional to those recited to the species claims and must comprehend within its confines the organization covered in each of the species.”

Applicant respectfully notes that claim 1 claims subject matter which the examiner considers to be embraced by species 1 **and** subject matter the examiner considers to be embraced by species 2. Specifically, claim 1 recites “a power bus backplane containing...” as element “a” and “a plurality of functional modules, each housing...” as element “b”. Applicant respectfully submits that, consequently, there is a generic claim in the application and that the examiner’s restriction requirement in this regard is without basis and should be withdrawn.

Applicant further notes the requirement to include an identification of all species that is elected consonant with this requirement and a listing of all claims readable thereon including any claims subsequently added. In accordance with that requirement, while applicant respectfully traverses the requirement and believes the requirement is misplaced since there is at least one generic claim pending in the application, as noted above, applicant, in addition to the election required above (in which applicant elected the claims of group 1 in response to the first part of the examiner’s restriction requirement) applicant now elects the claims of species 1 as the species to which prosecution on the merits shall be restricted if no generic claim is finally held to be allowable. The claims readable on, embracing and covering species 1 are believed to be claims 1 through 25, 35, 41 through 45 and 52 through 79 (all of which claims are believed to be readable on, to embrace and to cover both species) and claims 46 and 47 and claims 80 through 93, which are believed to be readable on, to embrace and to cover only species 1.

Applicant further traverses this requirement as to a genus/species restriction on the additional basis that it is inconsistent with the examiner's earlier restriction requirement dividing the claims into four separate groups on the basis of purported classification and alleged distinctness. Reconsideration and withdrawal of at least this second portion of the restriction requirement is respectfully solicited.

The Required Scope Of The Search

Applicant yet again notes that the most salient consideration for insisting upon restriction and determining the propriety of a restriction requirement is the scope of the examiner's search for prior art. Applicant is entitled to a full and thorough search of the prior art as a consequence of having filed his application and having paid the statutory application fee:

The director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the director shall issue a patent therefor. 35 U.S.C. 131

Restriction is proper only where an examiner would be unduly burdened by searching numerous, **unrelated** inventions or technologies. The scope of a search for related inventions, even though possibly burdensome, cannot by itself justify restriction of related inventions. If an application includes claims to related inventions which are distinct or independent inventions, the examiner **must** examine the application on its merits, in its entirety, if the search and examination of the entire patent application can be made without a serious burden on the examiner:

If the search and examination of **an entire application** can be made without serious burden, the examiner **must examine it on the merits, even though it includes claims to independent or distinct inventions**. MPEP 803.

In developing a search strategy and mapping the scope of a search, claims are to be given their broadest reasonable interpretation, both literally and by equivalents:

All subject matter that is the equivalent of the subject matter as defined in the claim, even though specifically different from the definition in the claim, must be considered unless expressly excluded by the claimed subject matter. MPEP 904.01(b)

The examiner will not be unduly burdened by searching and examining all of the claims presented by applicant in a single application. The examiner's search will not be narrowed or reduced by compliance with the restriction requirement, since applicant has clearly manifested his intent to claim each novel and nonobvious aspect of the disclosed functional module and power bus backplane subject matter in a power node control center, as evidenced by the claims in the application.

In this regard, applicant's claim 1 recites a modular power node which includes a power bus backplane and a plurality of functional modules. Claim 75 of group 2 is addressed to a power node control center including a power bus backplane and a plurality of functional modules. The power bus backplane language appears again in the claims of group 3 with these claims all being directed to a power bus backplane either alone or in combination with other structure. The claims of group 4 recite a module for use in connection with a power bus backplane. Hence, claims in each of the four groups recite modules and power bus backplanes thereby effectively defining the scope of the search which should be performed relevant to the patentable novelty and unobviousness of the claimed invention. Clearly, a search respecting any of the four groups of claims must encompass the appropriate classes and subclasses for the functional module component of the power node control center and the appropriate classes and subclass(es) for the power bus backplane component of the power node control center.

The examiner's instructional guidelines for performing a search for any application are set forth in the MPEP. The guidelines require the examiner to search in classes and subclasses in which *arguably distinct* (as defined by the MPEP) inventions would be classified:

"Not only must the art be searched with which the invention claimed is classifiable, but **also all analogous arts regardless of where classified.**

The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called. MPEP 904.01(c) (emphasis added).

A proper field of search normally includes the subclass in which the claimed subject matter of an application would be properly classified...

In outlining a field of search the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature, **that may have material pertinent to the subject matter as claimed.** Every subclass, digest and cross reference art collection pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. **The search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.** MPEP 904.02(a) (emphasis added).

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, **commensurate with the limitations appearing in the most detailed claims in the case,** be made in preparing the first action ... It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; **but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment.** MPEP 904.03, ¶ 1 (emphasis added)

In doing a complete search, the examiner should find and cite references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter regarded by applicant as his or her invention, by showing that this other subject matter is old or obvious. MPEP 904.03 ¶ 2

In selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's disclosure... MPEP 904.03 ¶ 3.

From the above-quoted guidelines, it is clear that the scope of a proper search includes:

- (1) Classes and subclasses in which the claimed subject matter is classified; this means classes and subclasses in which functional modules and power bus backplanes are classified must be searched;
- (2) Classes and subclasses that may have material pertinent to the claimed subject matter; this means classes and subclasses having material pertinent to functional modules and power bus backplanes, such as devices for connecting modules to power bus backplanes, must be searched;
- (3) Classes and subclasses containing subject matter present in the disclosure which might reasonably be expected to be claimed during the prosecution; this means designs for such modules and power bus backplanes must be searched; and
- (4) Classes and subclasses that may contain subject matter disclosing material related to features which might reasonably be expected to be claimed; this means classes for particular power bus bars must be searched.

The various disclosed and claimed structures, namely the functional modules, backplane, bus bars, control modules, power node control center, etc. are interrelated, work together and merit patent protection. They are all directed to a common technology, namely control and regulation of electrical power by functional modularly constructed nodes working together with power bus backplanes via which power is supplied and delivered, principally but not exclusively for shipborne applications. The claims stem from a set of core inventive concepts, namely modular construction of nodes performing control and power modification and monitoring tasks, receiving power from and supplying power to a bus via a connection backplane.

As demonstrated above, no matter which group of claims is examined, the search must embrace functional modules and power bus backplanes defining the power node control center subject matter. Accordingly, the searches performed by the examiner will be essentially identical regardless of which group of claims the examiner initially searches. As such, if the restriction requirement stands it will waste time, money and energy to perform the same search, namely a search in the classes and subclasses for functional modules and in the classes and subclasses for power bus backplanes, which together essentially define the power node control center, four times. This alone should be sufficient reason for the examiner to reconsider and withdraw the restriction requirement and to proceed with a meritorious examination of all of the claims pending in the application.

**The Proposed Restriction Would Be Unduly Economically
Burdensome On Applicant**

While the Patent and Trademark Office has a legitimate interest in obtaining proper revenue from filing, issuance and maintenance fees, it does not have unrestrained power to tax inventors or the entrepreneurial enterprises employing them. Applicant is entitled to obtain patent protection on each of the nonobvious inventive aspects of the subject matter which applicant has disclosed. If the applicant is forced to divide this application into four separate patent applications as suggested by the examiner, this will be unduly and unfairly burdensome to the applicant due to the extra fees and costs associated with prosecuting and maintaining three additional patents.

Table 1 sets forth the divisional application filing costs which would be incurred by the applicant in the event the restriction requirement stands:

TABLE 1: DIVISIONAL APPLICATION FILING COST

| Group Number | I | II | III | IV |
|--|------------|---------------|-----------------|---------------|
| Independent Claims | 5 | 1 | 1 | 1 |
| Excess Independent Claims | 2 | 0 | 0 | 0 |
| Excess Independent Claim Fee | 168.00 | 0 | 0 | 0 |
| Total Claims | 49 | 1 | 25 | 2 |
| Excess Claims | 29 | 0 | 5 | 0 |
| Excess Claims Fee | 327.00 | 0.00 | 90.00 | 0.00 |
| Basic Filing Fee | 750.00 | 750.00 | 750.00 | 750.00 |
| Total Filing Fee | 1,235.00 | <u>750.00</u> | <u>840.00</u> | <u>750.00</u> |
| Excess Filing Fees | | { | 2,360.00 | } |
| Already Paid by Applicant at Filing | | | 1,142.00 | |
| Already Paid by Applicant to Add Claims 52-79 | | | 744.00 | |
| Filing & Claims Fees Paid by Applicant to Date | | | 1,886.00 | |

As can be seen from Table 1, applicant will be forced to pay additional filing fees alone in the amount of \$2,360.00 if the restriction requirement is not withdrawn.

As further indicated on Table 1, applicant has already paid \$1,886.00 in filing and claims fees to date. If applicant is forced to adhere the restriction requirement, approximately \$1,200.00 of this will be forfeited since three of the independent claims and twenty-eight claims in total will not be examined in the instant application despite the fact that applicant has paid the filing fee therefor. Indeed, applicant will be forced to pay \$2,360.00 additional to secure examination of the three extra independent claims and the twenty-eight total extra claims for which applicant has already paid. Hence, applicant will pay an initial, non-recoverable government fee penalty of about \$2,960.00 in the event applicant is required to adhere to the outstanding restriction requirement.

Applicant further notes that the figures in Table 1 do not include attorney fees, associated costs and expenses. The attorney fees associated with filing each such divisional patent application would probably be around \$1,000.00; this figure is taken by analogy from the figure appearing in the AIPLA Report of Economics Survey 2001 for the filing of a previously prepared U.S. patent application in the United States as a PCT application.

Furthermore, applicant will be faced with preparing amendments and arguments in response to official actions to be issued by the United States Patent and Trademark Office. Again based on the AIPLA Report of Economics Survey 2001, from figures given for the costs to prepare an amendment and argument of minimal complexity it can be expected that the applicant will face fees of in the neighborhood of \$2,000.00 for each amendment and argument which may be required in response to an official action.

Additionally, there will be attorney fees associated with the payment of any issue fee if allowed claims are obtained and this will amount to about \$600.00 per application, again based on the AIPLA Report of Economic Survey 2001. Add to this fees for the preparation and filing of information disclosure statements, and the ordinary and routine reporting letters to the inventor-client, the result is that the attorney fees associated with the filing and prosecution of the three divisional applications could easily amount to \$6,000.00 or \$7,000.00 per application, leading to a further incremental cost to the applicant of from \$18,000.00 to \$21,000.00 if the restriction requirements stands.

Table 2 presents the patent issue fees and maintenance costs applicant will face in the event the restriction requirement stands and applicant is successful in prosecuting the parent application and three divisional applications to allowance:

TABLE 2: PATENT MAINTENANCE COST

| Number of Patents | 1 | 2 | 3 | 4 |
|---------------------------------|-----------------|------------------|------------------|------------------|
| Issue Fee | 1,300.00 | 2,600.00 | 3,900.00 | 5,200.00 |
| 1 st Maintenance Fee | 890.00 | 1,780.00 | 2,670.00 | 3,560.00 |
| 2 nd Maintenance Fee | 2,050.00 | 4,100.00 | 6,150.00 | 8,200.00 |
| 3 rd Maintenance Fee | 3,150.00 | 6,300.00 | 9,450.00 | 12,600.00 |
| TOTAL | 7,390.00 | 14,780.00 | 22,170.00 | 29,560.00 |

Even from Table 2, which presents the maintenance fee costs at today's level, it is apparent that applicant will face issue and maintenance fees amounting to \$22,170.00 extra, over and above the cost to issue and maintain a single patent directed to the invention, if the restriction requirement stands. When this figure is combined with the figures discussed above, the total financial penalty applicant faces in just official fees amounts to about \$27,000.00 as a result of the restriction requirement. If \$21,000.00 in attorneys fees are added, the total financial penalty resulting if the restriction requirement stands is about \$48,000.00. Applicant respectfully submits that applicant should not be burdened in this manner and that the restriction requirement should be reconsidered and withdrawn in its entirety.

Conclusion

For all of the foregoing reasons, applicant again respectfully submits that the third restriction requirement set forth in the paper dated 9 April 2003 is not well founded and

should be withdrawn. Applicant again requests prompt and thorough examination of all of the claims pending in the application.

In the event there is any fee required in connection with this submission, please charge the same to applicant's undersigned counsel's deposit account 50-1943.

Respectfully submitted.

Date: August 12, 2003

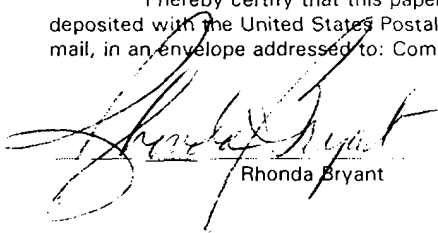


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**CERTIFICATE OF MAILING
UNDER 37 C.F.R. 1.8(a)**

I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450


Rhonda Bryant

Date: 12 August 2003